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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,527	07/24/2003	Yoshinori Yoshida	Q76642	8152

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EXAMINER

DESAI, ANISH P

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/625,527

Applicant(s)

YOSHIDA ET AL.

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/24/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on 03/02/04 in a preliminary amendment. The examiner is accepting the drawings received in the preliminary amendment. The applicant has stated in the preliminary amendment that "Applicant notes that the only number included in the figures and not in the original specification is the number "6". Applicant is prepared to delete reference number 6, if required by the Examiner." The examiner will accept the "reference number 6" if the applicant includes it in the specification.

### ***Election/Restrictions***

2. Applicant's election of Group I, claims 1-12 drawn to a pressure sensitive adhesive sheet in the reply filed on 08/09/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Objections***

3. Claim 11 is objected to because of the following informalities: Claim 11 recites "a multi-player sheet". It should recite "a multi-layer sheet". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites the limitation "first layer" in line 24. There is insufficient antecedent basis for this limitation in the claim. The examiner is interpreting "first layer" as "first film".

***Claim Rejections - 35 USC § 102/103***

5. Claims 1-12 are rejected under 35 U.S.C. 102 (b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagamoto et al. (US Patent 6,156,423).
6. Nagamoto et al. teach a base material for an adhesive tape and adhesive tape having such a base material to be used in the process of precision-machining of an optical structural element such as lens, a semiconductor structural element such as a silicon wafer, or the like (Column 1, lines 6-10). The adhesive tape 5 is formed by applying an adhesive layer 4 on the surface of the barrier layer 2 of the base layer 3 (Column 5, lines 49-51). Note that the base layer 3 comprises a film layer 1 and a barrier layer 2 is laminated on the film layer 1 (Column 3, lines 60-65). The film layer 1 is made of a urethane (meth) acrylate oligomer (Column 4, lines 66, Column 4, lines 1-6). The examiner is equating the film layer 1 of Nagamoto et al. as the claimed composite film and barrier layer 2 as the claimed first film. Note that the urethane

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(meth) acrylate has a vinyl group and a urethane polymer as claimed in the claim 1.

The vinyl group is present in the (meth) acrylate. The barrier layer is comprised of polyethylene terephthalate (PET), polyethylene naphthalate (PEN) etc. (Column 4, lines 58-64) which is of different material than the film layer 1.

7. Regarding the claims 1, 2, and 11, although Nagamoto et al. do not explicitly teach the claimed property of the modulus as claimed in the claims 1, 2, and 11, it is reasonable to presume that the said property is necessarily present in the invention of Nagamoto et al. Support for such presumption is found in the use of like materials. For example, applicant is reciting various thermoplastic resins such as PET, polyethylene, and polyurethane in the specification (Specification, Page 10) and Nagamoto et al. teach that the barrier layer 2 may be comprised of PET, polyethylene, polyurethane etc. (Column 4, lines 57-64). Additionally, the applicant has stated in the specification that acrylic based pressure sensitive adhesives are preferred (Specification, Page 25). The adhesive layer of Nagamoto et al. includes adhesives that are disclosed in the JP Patent Application Publication No. 5-77284 and 62-153376 (Column 5, lines 51-55). Note that the JP Patent Publication No. 62-153376 discloses acrylic based pressure sensitive adhesives (translation relied upon the corresponding US Patent 4,756,968, Column 6, lines 14-22). Moreover, as stated previously, the film layer 1 of Nagamoto et al. contains a urethane polymer and a vinyl polymer. The burden is upon the applicant to prove it otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of the modulus would obviously have been present once the product (i.e. adhesive tape) of Nagamoto et al. is provided. Note *In re Best*, 195, USPQ at 433,

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footnote 4 (CCPA 1977) as to providing of this rejection made above under 35 U.S.C. 102.

8. Regarding the claim 3, the film layer 1 of Nagamoto et al. is made of urethane (meth) acrylate oligomer (Column 4, lines 66, Column 4, lines 1-6). Thus, the film layer 1 contains acrylic polymer.

9. Regarding the claim 4, note that the claim 4 is a product by process claim. Product by process claim is not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

10. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). In the instant case the product (i.e. adhesive tape) of Nagamoto et al. is formed by applying an adhesive layer 4 on the surface of the barrier layer 2 of the base layer 3 (Column 5, lines 49-51). The base layer 3 comprises a film layer 1 and a barrier layer 2 laminated on the film layer 1

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(Column 3, lines 60-65). Moreover, recall that the film layer 1 of Nagamoto et al. is made of urethane (meth) acrylate, which contains urethane polymer and vinyl polymer.

11. The use of 35 USC 102/103 rejections for product by process claims has been approved by the courts. "[T]he lack of physical description in a product by process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product by process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 173 USPQ 685, 688 (CCPA 1972).

12. Regarding the claim 5, recall that the film layer 1 of Nagamoto et al. is made of urethane (meth) acrylate oligomer (Column 4, lines 66, Column 4, lines 1-6). Thus, the film layer 1 contains acrylic polymer.

13. Regarding the claims 6 and 7, although Nagamoto et al. do not explicitly teach the claimed properties of the storage modulus of the composite film and the storage modulus of the first film, it is reasonable to presume that the said properties are necessarily present in the invention of Nagamoto et al. Support for such presumption is found in the use of like materials. For example, the film layer 1 of Nagamoto et al. is

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made of urethane (meth) acrylate. Thus, the film layer 1 contains urethane polymer and vinyl polymer. The applicant has also claimed the composite film containing urethane polymer and vinyl polymer. Additionally, the barrier layer 2 of Nagamoto et al. is comprised of PET, polyethylene, polyurethane etc. (Column 4, lines 57-64) and the applicant has recited thermoplastic resins such as PET, polyethylene, and polyurethane in the specification that can be useful in forming the first film (Specification, Page 10). The burden is upon the applicant to prove it otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed properties would obviously have been present once the product (i.e. adhesive tape) of Nagamoto et al. is provided. Note *In re Best*, 195, USPQ at 433, footnote 4 (CCPA 1977) as to providing of this rejection made above under 35 U.S.C. 102.

14. Regarding the claims 8 and 10, the thickness of the barrier layer of Nagamoto et al. is 0.1 micrometer to 40 micrometer (Column 3, line 30) and the thickness of the film layer of Nagamoto et al. is 100 to 490 micrometer (Column 4, lines 49-50). Thus, the thickness of the barrier layer meets the claimed thickness of 10 micrometer or more and 200 micrometer or less of the claimed first film and the thickness of the film layer of Nagamoto et al. meets the claimed thickness of 10 micrometer or more and 300 micrometer or less of the composite film. Additionally, the thickness of the barrier layer and the film layer of Nagamoto et al. meets the claimed ratio of the thickness.

15. Regarding claims 9 and 12, in addition to the previously disclosed matters of Nagamoto et al., the barrier layer can be on the both sides of the film layer (Column 5, lines 61-65).



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***Conclusion***

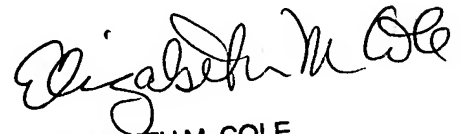
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467.

The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

  
ELIZABETH M. COLE  
PRIMARY EXAMINER